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ELECTION

Applicant elects, with traverse, what the Examiner has characterized as "Invention 1", deemed drawn to a magnetic field generator assembly, including a plurality of magnetic elements, and corresponding to claims 1-8.

REMARKS

The Examiner has identified three alleged 'inventions' in the pending claims. The Examiner's classification of the 'inventions' includes Group I consisting of claims 1-8 drawn to a magnetic field generator assembly, including to a plurality of magnetic elements and classified by the Examiner in class 335, subclass 296; Group II consisting of claims 9-15 drawn to a magnetic resonance imaging apparatus and classified by the Examiner in class 324, subclass 31; and Group III consisting of claims 16-22, drawn to a method of manufacturing a magnet element assembly for an MRI apparatus and classified by the Examiner in class 29, subclass 602.1.

Applicant has amended claim 16 to correct a typographical error. Specifically, the word "elements" has been inserted to correct its inadvertent omission. Thus, claim 16 is now more clear in calling for the step of "assembling a plurality of magnetic elements to form a multi-element magnet." This amendment is intended in no way to be a limiting amendment.

The Examiner stated that "[a] telephone call was made to Mr. Jay Chaskin to request an oral election to the above restriction requirement, but did not result in an election being made." However, Applicant notes that the Declaration clearly states that all correspondence and telephone calls should be directed to the undersigned. Applicant is unclear why the Examiner would attempt to contact "Mr. Jay Chaskin" or at what number the Examiner could attempt such a call.

Regarding the identified Group I and Group II "inventions," the Examiner indicated that the groups are related as combination (Group II) and subcombination (Group I). Although the Examiner stated that "inventions I and II are related as combination and subcombination", Application assumes the Examiner meant to identify invention II as the combination and invention I as the subcombination since invention II (claim 9) includes a magnetic assembly similar to that called for in claim one, together with other elements, such as the gradient coils and RF transceiver system. The Examiner is requested to correct this error in a further response if all the claims are not rejoined.

In order to support this restriction, the Examiner stated that the combination as claimed does not require the particulars of the subcombination as claimed "because the combination can

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have an electromagnet or a single magnet to generate [the] required magnetic field." However, an examination of the elements of the claims of each group evidences the interrelation therebetween. Claim 1 of Group I calls for, in part, "a plurality of magnetic elements configured to collectively generate a magnetic field," and claim 9 of Group II calls for, in part, a "magnetic assembly include[ing] at least one multi-element magnet." Therefore, the Examiner's statement is not consistent with the elements of the claims. Additionally, claim 1 of Group I calls for "a non-magnetizable pane," and claim 9 of Group II calls for "at least one non-magnetizable sheet." The interrelationship between these claims is self-evident. One of ordinary skill in the art would readily recognize the similarity between these alleged groups. For these reasons alone, the restriction requirement is not sustainable.

Furthermore, the Examiner's statement asserting that the apparatus of Group II could utilize an electromagnet does not show that the combination (Group II), does not require the particulars of the subcombination (Group I). If, as the Examiner asserts, the scope of the claims of Group II encompasses an electromagnet, the Examiner has not shown why the scope of the claims of Group I does not also encompass an electromagnet. As shown above, the elements of claim 1 in Group I and claim 9 in Group II are clearly interrelated and the Examiner has not shown why an electromagnet falls within the scope of claim 9, but not claim 1. Thus, the proffered example of an electromagnet fails to demonstrate that the combination does not require the particulars of the subcombination. For this additional reason, the restriction requirement is unsustainable.

Similarly, the statement that the apparatus of Group II could utilize a "single magnet" proves nothing about whether the combination requires the particulars of the subcombination. Despite the ambiguity of the phrase "single magnet," Applicant believes that such an example is inapplicable to the claims of either Group I or Group II. If "single magnet" implies a magnet with one magnetic element, then the example does not fit within the scope of either claim 1 or claim 9, as both call for multiple magnetic elements. If, however, "single magnet" simply refers to one multi-element magnet, then such example could fall within the scope of both claims 1 and 9. Therefore, the example proffered by the Examiner does not prove anything about whether the combination recites the particulars of the subcombination. Otherwise stated, the Examiner has completely failed to show that the "combination as claimed does not set forth the details of the subcombination as separately claimed." MPEP §806.05(c). Therefore, since restriction under MPEP §806.05(c) requires two-way distinctness, and since the Examiner has failed the first

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requirement for distinctness as set forth in §806.05(c), the restriction between Group I and Group II must be withdrawn and these claims rejoined.

Furthermore, the example of separate utility of Group I does not support distinctness since it does not show that Group I has "acquired a separate status in the art because of [its] divergent subject matter," as the Examiner has claimed. The Examiner stated that Group I "has separate utility such as use in magnetic resonance spectrometers." However, Group II was classified by the Examiner in class 324, subclass 318. This classification is designated as "Spectrometer components." Thus, the Examiner has not shown that Group I has separate utility that constitutes subject matter divergent from Group II. It follows that the scope of a proper search of Group I would necessarily overlap a proper search of Group II.

Regarding Group I and Group III, the Examiner indicated that the groups "are related as process of making and product made." In support of this, the Examiner stated that "[i]n the instant case, the product as claimed can be an electromagnet or a single magnet made of magnetic material, which is made by a different process." However, the Examiner never said what that process is, but merely said it is a "different process". That is not the correct test though. The correct test is a "materially different process". MPEP §806.05(f). For this reason alone, the Examiner's restriction between Groups I and III is not sustainable.

Further, the Examiner essentially asserted that Group I encompasses products, such as an electromagnet or a single magnet. This is in direct contradiction to the restriction between Group I and Group II, in which the Examiner indicated that an electromagnet and a single magnet do not fall within the scope of the claims of Group I. Notwithstanding the inconsistency, Applicant believes that the restriction between Groups I and III is unsupported and that the proffered examples to prove distinctness are inapplicable.

As an example of Group I being made by "another and materially different process," the Examiner stated that Group I, the product, "can be an electromagnet or a single magnet made of magnetic material." However, if an electromagnet or a single magnet falls within the scope of Group I, the Examiner has failed to show how such would not fall within the scope of Group III. Specifically, claim 1 in Group I calls for, in part, "a plurality of magnetic elements configured to collectively generate a magnetic field." Similarly, claim 16 of Group III calls for the step of "assembling a plurality of magnetic elements to form a multi-element magnet." One of ordinary skill in the art would clearly recognize the similarity and interrelation of the elements of these claims. Therefore, the Examiner failed to show that the products falling within the scope of

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Group I can be made by a process materially different than that of Group III. The Examiner also did not attempt to show that the process of Group III can be used to make other and materially different products which do not fall within the scope of Group I. Thus, MPEP §806.05(f) has not been satisfied and restriction between Groups I and III is improper.

Regarding Group II and Group III, the Examiner indicated that the groups are related as process of making (Group III) and product made (Group II). In support of this, the Examiner first stated simply that "the product could be made by another and materially different process." Thereafter, the Examiner added the equally unsupported statement that "the product as claimed can be a single magnet or an electromagnet, which is (sic) made by different process[e]s."

Once again, the Examiner failed to substantiate the proffered example. If an electromagnet or a single magnet falls within the scope of Group II, the Examiner did not show how such would not fall within the scope of Group III. Specifically, claim 9 of Group II calls for, in part, a magnetic assembly which includes "at least one multi-element magnet." Likewise, claim 16 of Group III calls for the step of "assembling a plurality of magnetic elements to form a multi-element magnet." Thus, an examination of the elements of the claims of Group II and Group III evidences an interrelation therebetween. Therefore, the Examiner did not show that the product (Group II) could be made by another and materially different process. Additionally, as before, the Examiner did not even attempt to show that the process (Group III) can be used to make other and materially different products which fall outside the scope of Group II. Therefore, MPEP §806.05(f) has not be satisfied, and restriction between Group II and Group III is improper and the holding must be withdrawn.

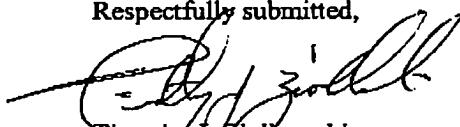
Thus, it has been shown that restriction between each of the alleged groups is improper. The examples proffered to support restriction between Group I and Group II are unsupportive of the requisite two-way distinctness; the example to support restriction between Group I and Group III does not show that Group I can be made by a process materially different than that of Group III; and the example provided to support restriction between Group II and Group III does not show that Group II can be made by a process materially different than that of Group III. For all these reasons, Applicant respectfully requests rejoinder of all claims, of each group. The Examiner is reminded to address all correspondence and telephone calls to the undersigned and is

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invited to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,



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